

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Davis et al.

Application No.: 09/502,542

Filed: February 10, 2000

For: **METHOD AND SYSTEM FOR
FACILITATING ON-LINE SHOPPING**

Examiner: M. Fadok

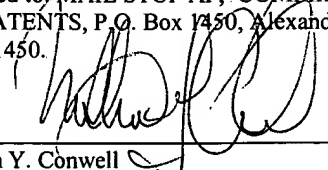
Date: March 6, 2006

Art Unit 3625

Confirmation No. 5321

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on March 6, 2006 as First Class Mail in an envelope addressed to: MAIL STOP AF, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.


William Y. Conwell
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants requests review of the appealed-from rejection in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than five attached pages are provided.)

Date: March 6, 2006

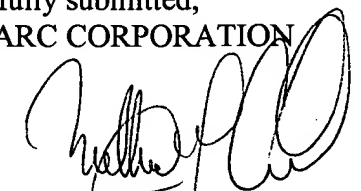
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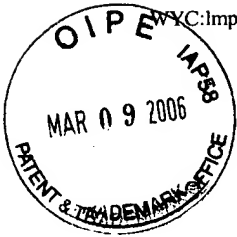
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Respectfully submitted,
DIGIMARC CORPORATION

By


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**REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The Board will reverse the rejections. A few reasons for reversal are noted below.

All claims stand rejected over Swartz (6,243,447) – either solely, or in combination with other art. For example, claim 1 is rejected as anticipated by Swartz.

This anticipation rejection will be reversed, *e.g.*, because Swartz fails to teach the last two clauses of claim 1.

Swartz discloses a self-checkout system for a retail store, in which a shopper equipped with a personal barcode scanner scans items put into their grocery cart, thereby generating a list. At the checkout register, a cashier retrieves the scanned list and charges the shopper accordingly.¹

Swartz's scanner can also be used to compile a predicted shopping list (based on a shopper's historical shopping practices), which may be retrieved by the shopper for later use at the store.²

In claim 1, as in other claims, applicants have emphasized the interrelationship between activities (1) in a bricks and mortar store, and (2) in an online shopping environment. Swartz concerns just a bricks and mortar store. He does not teach any online shopping environment.

Contrary to the Final Action, col. 8, lines 7-53 of Swartz does not teach “*using said recalled list ... in an on-line shopping environment.*” Rather, this passage teaches compiling a list of items while shopping in a retail (*i.e.*, bricks and mortar) store.

Likewise contrary to the Action, Swartz col. 3, lines 18-39 does not teach “*receiving input from a user identifying a subset of items from said customized selection of items [presented in the on-line shopping environment].*” Rather, this passage again teaches creation of a list while shopping in a retail store (and the use of such a list as a “predicted shopping list” during subsequent shopping).

¹ Swartz, US 6,243,447, col. 3, lines 43-64.

² Swartz, US 6,243,447, col. 3, lines 35-39.

The § 102 rejection of claim 20 will fail similarly. Swartz does not teach “*using the data thereby acquired [during a shopper’s visit to a bricks and mortar store] in a later on-line shopping session with said shopper.*” (The Action does not particularly provide a citation in connection with this clause from claim 20, instead saying “see response to claim 1.” Again, the passages from Swartz cited in connection with claim 1 do not teach the claimed relationship between activities in a bricks and mortar store, and subsequent activities in an online shopping environment.

The § 103 rejection of independent claim 3 (over Swartz and alleged Official Notice) will fail because Swartz again fails to teach that for which it is cited.

For example, claim 3 is drawn to “a method of conducting an *online* shopping session.” Contrary to the Final Action, Swartz does not concern an online shopping session. Rather, his disclosure concerns retail shopping environments, with physical aisles and physical checkout registers, etc. This is the opposite of the online shopping arrangement required by the claim language. (Note that the “online” limitation is found not just in the claim preamble, but also in the body of the claim – in the last clause.)

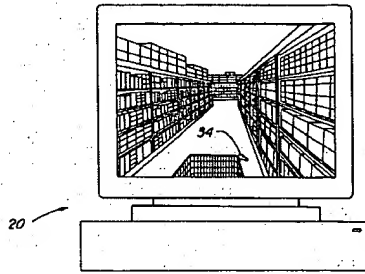
Moreover, claim 3 requires, “*querying the user regarding possible purchase of an item not selected by the user but on said recalled list, before completing the online shopping session.*” The Final Action acknowledges that Swartz has no disclosure on this point.

In the latest Action, the Office offered Ogasawara as curing Swartz’s shortcomings. However, like Swartz, Ogasawara concerns shopping in a bricks and mortar store. Ogasawara does not teach the claim limitation of “*querying the user ... before completing the online shopping session.*”)

The § 102 rejection of independent claim 7 will fail, *e.g.*, because Swartz again fails to teach that for which it has been cited. The claim requires “*logging a shopper’s habits or preferences exhibited in an on-line shopping environment...*” (The claim concludes by requiring use of the logged information in connection with bricks and mortar shopping by the user.)

Again, the Action has ignored the “on-line shopping environment” requirement of the claim. Swartz, in contrast, teaches only shopping in a conventional retail (*i.e.*, bricks and mortar) environment.

Independent claim 9 stands rejected over Kenney in view of Swartz. Kenney teaches a virtual shopping arrangement having a visual look like that of a physical store:



Among other failings, the rejection of claim 9 will be reversed because Swartz again does not teach that for which it has been cited - "a method of on-line shopping." The Final Action states, "*Swartz teaches scanning data on a device, which can later be used to purchase products on-line (see response to claim 1).*"

Not so. As noted, Swartz does not teach purchasing products on-line.

Because the art does not teach that for which it has been cited, the Action falls short of the *prima facie* burden required to establish obviousness of claim 9.

Independent claims 17 and 19 also stand rejected over Kenney in view of Swartz, and are likewise premised on the erroneous belief that Swartz teaches purchasing products on-line. Again, this error will lead to reversal of the claim 17 and 19 rejections.

Moreover, claim 17 will be recognized as including all of the language of claim 9, to which is added the concluding limitation, "*wherein said items of potential interest include at least one item that the shopper has not previously purchased from said first vendor.*" The Final Action dismisses this by reference to the "Special Today" indicia shown in Kenney's Fig. 7.

However, Kenney does not teach that the product marked "Special Today" in his Fig. 7 is an item "that the shopper has not previously purchased from said first vendor," as required by claim 17. Again, this failure of the art to teach that for which it cited will lead the Board to reverse the rejection.

In addition to the above-noted error in the Office's rejection of claim 19, the claim also requires displaying a virtual shopping aisle in which items of potential interest – identified by sensing data from products while at the shopper's residence – are presented more prominently than other items.

While Swartz suggests that products may be identified with his scanner at the shopper's residence, the Action resorts to impermissible hindsight to suggest that products identified in this way be presented more prominently than other items. Neither Swartz nor Kenney has a suggestion leading to such an arrangement. Again, the rejection falls short.

Independent claim 18 stands rejected over Kenney in view of Swartz and *St. Regis Paper Co. v. Bemis*, 193 USPQ 8. Claim 18 is patterned after claim 9, and the Office's rejection of claim 18 is similarly patterned after its rejection of claim 9 – including the erroneous assertion that Swartz teaches a method of on-line shopping. Again, this error in application of Swartz will lead to reversal of the rejection.

Moreover, claim 18 is directed to a method of on-line shopping from a first vendor, which relies on transactions with vendors *other than said first vendor*.

The Final Action acknowledges that both Kenney and Swartz are silent on this feature. However, resort is made to the *St. Regis* case. However, the Board will recognize that this is not sufficient to suggest the claimed arrangement (of referring to a history including transactions with vendors other than the first vendor).

For brevity's sake, the foregoing discussion has reviewed just the eight independent claims pending in the application, and only selected points have been reviewed in connection with each. Many other points that might have been raised concerning the claims, the art, and the rejections, have not been belabored.

Nonetheless, the foregoing brief observations are believed sufficient to establish that the outstanding rejections would not be sustained by the Board.